

## **REMARKS**

### **I. Introduction**

Claims 1 to 27 are pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

### **II. Summary of Telephone Interview**

In response to the Final Office Action dated September 16, 2004, a telephone interview was conducted on December 1, 2004, between Applicants' representative Thomas C. Hughes, Esq. (U.S. Reg. No. 42, 674) and Examiner Roberts Culbert of the U.S. Patent and Trademark Office. Subsequent to the telephone interview, Applicants submitted by facsimile on December 7, 2004, a Proposed Amendment to Claim 1. Further discussion was made on December 21, 2004. Applicants submit herein a Summary of the Interview in accordance with Section 713.04 of the Manual of Patent Examining Procedure.

As an initial matter, Applicant notes with appreciation the courtesies extended by Patent Examiner Culbert during the course of the above-referenced telephone interview. Only claim 1 was specifically discussed during the course of the interview. The cited prior art reference U.S. Patent No. 5,660,642 was also discussed during the course of the interview. Tentative agreement with respect to the patentability of claim 1, as proposed in the amendment, was reached, but it was agreed that such patentability would be further considered in view of the eventual amended claim language presented herein.

During the course of the interview, the general thrust of the principal arguments made by Applicants is that does not disclose, or even suggest, moving an object and a tank sequentially in two or more directions relative to each other. Rather, it was agreed that Britten at most shows movement of a substrate and a fluid meniscus-containing reservoir in a single direction, even though the fluid meniscus itself may flow backwards during the Marangoni flow discussed therein.

### **III. Rejection of Claims 1 to 19 and 23 to 27 Under 35 U.S.C. § 103(a)**

Claims 1 to 19 and 23 to 27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,660,642 ("Britten") in view of U.S. Patent No. 5,171,393 ("Moffat"). Applicants respectfully submit that claims 1 to 19 and 23 to 27 are not unpatentable for at least the following reasons.

Claim 1 relates to a fluid meniscus process. Claim 1 recites that the process includes the step of holding at least a portion of a first surface of an object with a holding fixture, such that at least a portion of a second surface of the object is exposed. Claim 1 recites that the process includes the step of injecting at least one fluid in a tank such that a fluid meniscus is formed. Claim 1 also recites that the process includes the step of contacting at least a portion of the second surface of the object with at least a portion of the fluid meniscus. Claim 1 has been amended herein without prejudice to recite that the process includes the step of moving the object and the tank sequentially in two or more directions relative to each other. Support for this amendment can be found, for example, at page 8, lines 20 to 22 of the Specification which states that “[t]he substrate 14, could be ... scanned over the fluid meniscus 16, as many times as necessary to achieve the desired results”, and at page 8, line 25 to page 9, line 2 of the Specification which states that “Fig.1A-1D, illustrate schematically such motion as it progresses from right (Fig. 1A) to left (Fig. 1B, 1C), and back to the right (Fig. 1D).” Still further, the Specification states at page 9, lines 7 to 9, that “the substrate module 12 [ ] may ... contain[ ] the motors, chucks and feedthroughs necessary to achieve the previously described motions.” Claim 1 further recites that the process includes the step of removing the object after at least one contact with the fluid meniscus.

Respectfully, the combination of Britten and Moffat does not render claim 1 unpatentable for at least the reason that the combination of Britten and Moffat does not disclose, or even suggest, all of the limitations of claim 1. For instance, the combination of Britten and Moffat does not disclose, or even suggest, moving the object and the tank sequentially in two or more directions relative to each other, as recited in claim 1. As more fully set forth above, the Specification describes that, in one embodiment, the substrate 14 is scanned over the fluid meniscus 16 one or more times such as by scanning to the right, to the left, etc.

In contrast, Britten purports to describe a device and process in which a substrate is moved relative to a holding tank having a fluid meniscus in a single direction. Specifically, Britten describes that “[t]he applicator assembly 8 comprises processing applicator 10 and rinse applicator 14, and is placed in close proximity to an inverted substrate surface 26 to be processed, such that the processing fluid 12 and the rinse water 16 both attach to the inverted substrate surface 26, forming menisci.” Column 3, lines 18 to 23. Britten further describes that “[t]he applicator assembly 8 is then translated relative to the substrate surface 26 such that an area on the substrate is first contacted by the processing fluid 12 and then the rinse water 16.” Column 3, lines 23 to 26. The evaporated solvent 20

that is provided in the reservoir 18 absorbs into the thin film 36 of the rinse water 16 located on the substrate surface 26, inducing the fluid to flow back to the rinse applicator 14 via a “Marangoni flow.” See, for instance, column 3, lines 29 to 38. Britten does not describe that the object and the internal assemblies 15, 17 in which the fluid menisci are formed are moved relative to each other in two or more directions, rather they are moved only in one direction, e.g., the direction shown by the arrow in Figure 1. In fact, the device of Britten will not operate if the substrate and the internal assembly 15, 17 having the fluid menisci are moved in any direction other than the direction shown by the arrow in Figure 1. Specifically, only when the substrate 26 is moved in one direction, i.e., the left-pointing direction shown by the arrow in Figure 1, relative to the internal assemblies 15, 17 will the wetted portion of the substrate surface 26 be brought into the proximity of the drying vapors of reservoir 18. If the substrate 26 is moved in a different direction relative to the internal assemblies 15, 17, the wetted portion of the substrate surface 26 will not be brought into the proximity of the drying vapors of reservoir 18.

Furthermore, Moffat is not relied upon to describe or suggest, and in fact does not describe or suggest, the features not described or suggested by Britten. Specifically, Moffat does not disclose, or even suggest, moving the object and the tank sequentially in two or more directions relative to each other, as recited in claim 1.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a prima facie case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). As indicated above, nowhere does the combination of Britten and Moffat disclose, or even suggest, moving the object and the tank sequentially in two or more directions relative to each other, as recited in claim 1.

Since the combination of Britten and Moffat does not disclose, or even suggest, all of the limitations of claim 1 as more fully set forth above, it is respectfully submitted that the combination of Britten and Moffat does not render obvious claim 1.

Furthermore, it is respectfully submitted that the combination of Britten and Moffat does not render obvious claims 2 to 19 and 23 to 27, which depend from claim 1 and therefore include all of the limitations of claim 1. Thus, it is respectfully submitted that claims 2 to 19 and 23 to 27 are allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious).

Therefore, withdrawal of this rejection, and allowance of claims 1 to 19 and 23 to 27, is respectfully requested.

**IV. Rejection of Claim 20 to 22 Under 35 U.S.C. § 103(a)**

Claims 20 to 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Britten in view of Moffat and U.S. Patent No. 5,279,703 ("Haberger"). Applicants respectfully submit that claims 20 to 22 are not unpatentable for at least the following reasons.

Respectfully, the combination of Britten, Moffat and Haberger does not disclose, or even suggest, all of the limitations of amended claim 1, from which claims 20 to 22 ultimately depend. As set forth more fully above, the combination of Britten and Moffat does not disclose, or even suggest, all of the limitations of claim 1. Furthermore, Haberger is not relied upon to describe or suggest, and in fact does not describe or suggest, the features not described or suggested by the combination of Britten and Moffat. Specifically, Haberger does not disclose, or even suggest, moving the object and the tank sequentially in two or more directions relative to each other, as recited in claim 1.

Since the combination of Britten, Moffat and Haberger does not disclose, or even suggest, all of the limitations of claim 1 as more fully set forth above, it is respectfully submitted that the combination of Britten, Moffat and Haberger does not render obvious claims 20 to 22, which depend from claim 1 and therefore include all of the limitations of claim 1. It is respectfully submitted that claims 20 to 22 are allowable for at least the same reasons that claim 1 is allowable. In re Fine, supra (any dependent claim that depends from a non-obvious independent claim is non-obvious). Therefore, withdrawal of this rejection, and the allowance of claims 20 to 22, is respectfully requested.

V. **Conclusion**

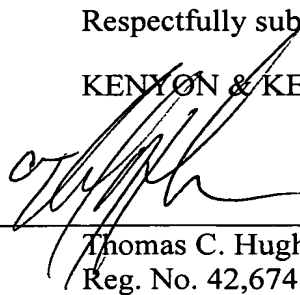
Applicants respectfully submit that all of the pending claims of the present application are now in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

KENYON & KENYON

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By: \_\_\_\_\_



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